



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED
AUG 13 2001
Technology Center 2100

Regular Patent Application of:)
)
Ravi ACHARYA, et al.)
)
Serial Number: 09/506,434)
)
Filed: February 18, 2000)
)
For: SYSTEM AND METHOD FOR)
ELECTRONIC DEPOSIT OF THIRD-)
PARTY CHECKS BY NON-)
COMMERCIAL BANKING CUSTOMERS)
FROM REMOTE LOCATIONS)

Group Art Unit: To Be Assigned

Examiner: To Be Assigned

TRMB
8-29-01

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

PETITION UNDER 37 C.F.R. § 1.102

This is a Petition under 37 C.F.R. 1.102 for accelerated examination of the application above. The application above is a regular utility application No. 09/506,434 filed February 18, 2000. The petition fee under 37 C.F.R. § 1.17(i) is enclosed. The Commissioner is authorized to charge any further fees or credit any overpayments to Deposit Account No. 50-0206.

This petition to make special is being made under MPEP 708.02(VIII). In accordance with that section, Applicants hereby request and submit:

- (A) The present Petition to Make Special with fee;
- (B) A set of claims (claims 1 - 24, and 27 - 29) directed to a single invention, as amended herewith on the same date as this petition in a preliminary amendment.

- (C) Applicants commissioned a pre-examination search in September 2000 in the following classes and subclasses:

<u>Class</u>	<u>Subclass</u>
235	379
283	58
380	243
382	137
705	30, 44, 45
713	176

RECEIVED
AUG 13 2001
Technology Center 2100

- (D) Applicants submit with this Petition one copy of all references found in the pre-examination search activity for this application (with additional copies as part of an Information Disclosure Statement filed herewith on the same date as this Petition).
See references U1 through U19 on FORM PTO 1449.

- (E) The three independent claims of the application, as amended in the preliminary amendment filed of even date herewith, are:

1. A system for depositing the value associated with conventional checks into the bank account of a customer payee comprising:

an interface to a customer terminal, the customer terminal being located remotely from a bank;

an automated banking system connected to the customer terminal interface via a communication link; and

an interface to a check clearing system, the check clearing system connected to the automated banking system via a communication link;

wherein the automated banking system is configured such that information from a conventional check is entered into the customer terminal, and;

wherein the automated banking system and check clearing system are configured to effectuate deposit of the discrete value of each check into an account of a customer payee.

15. A method for allowing a bank customer to deposit the value of conventional checks into a bank account from a location that is remotely situated with respect to a bank, comprising:

- (a.) receiving conventional checks payable to a bank customer;
- (b.) logging the bank customer payee onto an automated banking system from a customer terminal that is remotely situated with respect to a bank;
- (c.) entering transaction data into the customer terminal;
- (d.) processing the discrete value of each check for deposit by the automated banking system; and
- (e.) receiving a result of the transaction for each discrete check.

21. A method for allowing a bank to process check deposit transactions that are initiated by a bank customer at a remote location, comprising:

- (a.) receiving a request from a bank customer on a terminal that is remotely situated from a bank for authorization to make a transaction using an automated banking system;
- (b.) authorizing a bank customer payee as a user on the automated banking system;

(c.) receiving transaction data related to the deposit of a conventional check payable to the bank customer, where the payor is someone other than the bank customer; and

(d.) processing the deposit transaction for the discrete value of each check.

(F) Applicants submit a detailed discussion of the references from the search report as follows:

U1. 4,617,457

U.S. Patent No. 4,617,457 to Granzow et al. describes a teller-assisted, customer-operated ATM document cashing system. The invention disclosed by this reference functions in combination with both a teller station and a human teller. *See e.g.*, column 1, lines 30 - 34. By contrast, independent claim 1 recites "an automated banking system." Claim 1, line 5. Claims 15 and 21 recite similar limitations in lines 5 and 4, respectively. The reference therefore does not teach or suggest a system or method as claimed in the subject application, including at least "an automated banking system" and other recited features.

U2. 5,122,950

U.S. Patent No. 5,122,950 to Benton et al. discloses a method of and system for electronic funds transfer via facsimile machines. Operation of this invention requires "specially drafted transaction vouchers." *See e.g.*, column 6, line 5 and Figure 3. By contrast, independent claim 1 recites operation on a

“conventional check.” Claim 1, line 10. Claims 15 and 21 recite similar limitations in lines 4 and 8, respectively.

The reference therefore does not teach or suggest a system or method as claimed in the present application, including at least operation on “conventional checks” and other recited features.

U3. 5,321,238

U.S. Patent No. 5,321,238 to Kamata et al. relates a banking apparatus for processing the bill and the check. The reference discloses that a teller must input account number and amount. *See, e.g.*, column 5 line 28 - 37 (describing step 21) and column 6 lines 45-46. This is dissimilar to independent claims 1 of the present application, which recites “an automated banking system” (i.e., not involving a teller). Claim 1, line 5. Claims 15 and 21 recite similar limitations in lines 5 and 4, respectively.

Additionally, the invention disclosed in U.S. Patent No. 5,321,238 is an apparatus “provided at a front counter” of a bank. *See, e.g.*, column 2, lines 36-38 and claim 1. By contrast, independent claim 1 of the present application recites “a customer terminal...located remotely from a bank.” Claim 1, lines 3-4. Claims 15 and 21 recite similar limitations in lines 6 and 3-4, respectively.

The reference therefore does not teach or suggest a system or method as claimed in the subject application, including at least “an automated banking system” with “remote” customer access and other recited features.

U4. 5,373,550

U.S. Patent No. 5,373,550 to Campbell et al. describes transmission of check images by way of a public switched telephone network. The reference discloses how account data may be transmitted between a sending financial institution and a receiving financial institution. *See e.g.*, column 1, lines 6-9; column 1, lines 53-57; and Figures 1 and 2. By contrast, independent claim 1 of the present application recites a "customer terminal" that is "located remotely from a bank." Claim 1, lines 3-4. Claims 15 and 21 recite similar limitations in lines 5-6, and 3-4, respectively. The reference therefore does not teach or suggest a system or method as claimed in the subject application, including at least a "customer terminal" that is "remote" from a bank and other recited features.

U5. 5,444,794

U.S. Patent No. 5,444,794 to Uhland, Sr. describes a check image capture system. The reference discloses that a teller must scan checks that are presented to him or her. *See, e.g.*, column 3, lines 58-61 and claim 1. This is dissimilar to independent claim 1 of the present application, which recites "an automated banking system" for use by a bank customer (i.e., without the need for a teller). Claim 1, line 5. Claims 15 and 21 recite similar limitations in lines 5 and 4, respectively.

Additionally, the invention disclosed in U.S. Patent No. 5,444,794 is enabled by an "image capture system...located at the site of a bank teller..." *See,*

e.g., column 3, lines 58-60. By contrast, independent claim 1 of the present application recites “a customer terminal...located remotely from a bank.” Claim 1, lines 4-5. Claims 15 and 21 recite similar limitations in lines 5-6, and 3-4, respectively.

The reference therefore does not teach or suggest a system or method as claimed in the subject application, including at least “automated” operation initiated at a location that is “remote” from a bank and other recited features.

U6. 5,583,759

U.S. Patent No. 5,583,759 to Geer discloses a mechanism for expediting the deposit, transport and submission of checks into the payment system. Because the invention by Geer is directed toward institutional users with very high check volumes, it discloses a method for processing “groups of checks.” *See e.g.*, column 4, lines 13 – 15; column 5, lines 25-26. By contrast, independent claim 1 of the present application recites processing “the discrete value of each check.” Claim 1, line 12. Claims 15 and 21 have similar limitations in lines 8 and 11. The reference therefore does not teach or suggest a system or method as claimed in the subject application, including at least the deposit of “the discrete value of each check” and other recited features.

U7. 5,590,196

U.S. Patent No. 5,590,196 to Moreau relates a secure payment method using facsimile. The reference discloses an automated transaction initiated by the

payor. *See, e.g.*, column 5, lines 52-55. By comparison, independent claim 1 relates to an apparatus configured for use by a "bank customer payee." Claim 1, line 13. Method claims 15 and 21 recite similar limitations in lines 5 and 6, respectively.

Moreover, the invention in U.S. Patent No. 5,590,196 utilizes a "value transfer form." *See e.g.*, column 6, lines 50-51, and claim 1 in column 14, lines 56-57. By contrast, independent claim 1 of the present application recites operation on a "conventional check." Claims 15 and 21 recite similar limitations in lines 4 and 8, respectively.

The reference therefore does not teach or suggest a system or method as claimed in the subject application, including at least a "payee" that seeks to process "a conventional check" and other recited features.

U8. 5,592,377

U.S. Patent No. 5,592,377 to Lipkin discloses a check cashing system. The reference discloses a manned operator station as part of the system. *See e.g.*, column 3 lines 4-7 and claim 1. This is dissimilar to independent claim 1 of the present application, which recites "an automated banking system" for use by a bank customer payee, without the need for an operator. Claim 1, line 5. Claims 15 and 21 recite similar limitations in lines 5 and 6, respectively. The reference therefore does not teach or suggest a system or method as claimed in the subject application including, at least a fully "automated" system and other recited features.

U9. 5,602,936

U.S. Patent No. 5,602,936 to Green et al. describes a method of and apparatus for document data recapture. The "processing" of the system in this reference relates to the capture, storage, and retrieval of information. *See, e.g.*, column 2, lines 29-67. Independent claim 1 of the present application, however, recites actual "deposit" of the check value. Claim 1, line 12. Claims 15 and 21 recite similar limitations in lines 8 and 11, respectively. The reference therefore does not teach or suggest a system and method as claimed in the subject application, including at least the "deposit" of checks and other recited features.

U10. 5,832,463

U.S. Patent No. 5,832,463 to Funk relates an automated system and method for checkless check transaction. The reference describes a system and method for transactions that are initiated at a point-of-sale, or at a bank location. *See, e.g.*, column 3, lines 37-39 indicating that in operation of the invention, an entry is performed by a bank teller or cashier; *see also* the preamble of independent claims 1 and 14 that specifically refer to point-of-sale transactions initiated by a payor. By comparison, independent claim 1 of the present application recites use by a "bank customer payee." Claim 1, line 13. Method claims 15 and 21 recite similar limitations in lines 5 and 6, respectively.

Moreover, transactions initiated at a bank location are in contrast to independent claim 1 of the present application which recites "a customer

terminal...located remotely from a bank.” Claim 1, lines 3-4. Claims 15 and 21 recite similar limitations in lines 5-6 and 3-4, respectively.

The reference therefore does not teach or suggest a system and method as claimed in the subject application, including at least use by a “payee” at a location that is “remote” from a bank and other recited features.

U11. 5,832,464

U.S. Patent No. 5,832,464 to Houvener et al. discloses a system and method for efficiently processing payments via check and electronic funds transfer. The reference describes a “point of identification terminal.” *See, e.g.*, column 4, lines 28-33. By contrast, independent claim 1 of the present application recites the actual “deposit” of a check value. Claim 1, line 12. Claims 15 and 21 recite similar limitations in lines 8 and 11, respectively.

Moreover, the transaction in this reference is performed by “a store clerk or other person.” *See e.g.*, column 4, lines 32-33, 40. By contrast, Claim 1 recites operation of an “automated banking system” by a “bank customer payee.” Claim 1, line 5. Claims 15 and 21 recite similar limitations in lines 5 and 6, respectively.

The reference therefore does not teach or suggest a system and method as claimed in the subject application, including at least a “deposit” transaction on “an automated banking system” and other recited features.

U12. 5,870,725

U.S. Patent No. 5,870,725 to Bellinger et al. describes a high volume financial image media creation and display system and method. It provides a system and method to capture, store, and retrieve check images. *See, e.g.*, column 8 lines 62-67; *see also* column 11, lines 22-31 indicating that the service enabled by the invention is providing digitized images of checks along with a monthly bank statement. By comparison, independent claim 1 of the present application recites actual “deposit” of a check into the account of a customer payee. Claim 1, line 12. Claims 15 and 21 recite similar limitations in lines 8 and 11, respectively. The reference therefore does not teach or suggest a system and method as claimed in the subject application, including at least the “deposit” of checks and other recited features.

U13. 5,897,625

U.S. Patent No. 5,897,625 to Gustin et al. relates an automated document cashing system. The reference discloses only a system and method for depositing a check from a customer payor. *See, e.g.*, column 12, lines 58-61 wherein the system reads the user’s account number from the payor’s check that is presented for deposit. This is dissimilar to the present application, wherein independent claim 1 recites operation by a “bank customer payee.” Claim 1, line 13. Claims 15 and 21 recite similar limitations in lines 5 and 6, respectively.

Moreover, U.S. Patent No. 5,897,625 teaches only notification of an expected deposit. *See e.g.*, column 15, lines 25-28 and Figure 13E including an

illustrative message at the conclusion of the transaction that says: "\$674.52 will be deposited into your account." By comparison, independent claim 1 recites actual "deposit" of the value of the check. Claims 15 and 21 recite similar limitations in lines 8 and 11, respectively.

Thus, the reference does not teach or suggest a system and method as claimed in the subject application, including at least operation by a "payee" for the actual "deposit" of checks and other recited features.

U14. 5,930,778

U.S. Patent No. 5,930,778 to Geer discloses a system for expediting the clearing of financial instruments and coordinating the same with invoice processing at the point of receipt. Because this invention is directed toward institutional users with very high check volumes, it is directed to a method for processing "groups of checks." *See e.g.*, column 5, lines 23 – 24; column 7, lines 33 – 34; column 11, lines 30 – 38. By contrast, independent claim 1 recites processing "the discrete value of each check." Claim 1, line 12. Claims 15 and 21 recite similar limitations in lines 8 and 11. The reference therefore does not teach or suggest a system or method as claimed in the subject application, including at least deposit of the "discrete value of each check" and other recited features.

U15. 5,940,844

U.S. Patent No. 5,940,844 to Cahill et al. describes a method and apparatus for displaying electronic image of a check. The reference relates a

means for archiving and retrieving documents such as checks. *See, e.g.*, column 1, lines 12-18. and Figure 1. The purpose of the invention in U.S. Patent No. 5,940,844 is to more efficiently prove, after the fact, that transactions have been completed in the conventional manner. *See, e.g.*, column 5, lines 15-18. Independent claim 1, however, recites the actual "deposit" of checks. Claim 1, line 12. Claims 15 and 21 recite similar limitations in lines 8 and 11, respectively. The reference therefore does not teach or suggest a system or method as claimed in the subject application, including at least the actual "deposit" of checks and other recited features.

U16. 5,987,439

U.S. Patent No. 5,987,439 to Gustin relates an automated banking system for making change on a card or user account. This reference teaches similar subject matter as U.S. patent No. 5,897,625 above, disclosing a system and method for depositing a check from a customer payor. This is dissimilar to the present application, wherein independent claim 1 recites operation by a "bank customer payee." Claim 1, line 13. Claims 15 and 21 recite similar limitations in lines 5 and 6, respectively.

U.S. Patent No. 5,987,439 also relates to a system and method for crediting a customer's card or account in lieu of dispensing coin at an ATM. By contrast, independent claim 1 of the present application recites the actual "deposit" of a check. Claim 1, line 12. Claims 15 and 21 recite similar limitations in lines 8 and 11, respectively.

The reference therefore does not teach or suggest a system or method as claimed in the subject application, including at least the “deposit” of a check by a bank customer “payee” and other recited features.

U17. 6,038,553

U.S. Patent No. 6,038,553 to Hyde, Jr. discloses a self-service method of and system for cashing checks. The reference enables the *cashing* of checks, *see e.g.*, column 1, lines 66-67. Independent claim 1 of the present application, however, recites the “deposit” of a check. Claim 1, line 12. Claims 15 and 21 recite similar limitations in lines 8 and 11, respectively. The reference therefore does not teach or suggest a system or method as claimed in the subject application, including at least the “deposit” of a check and other recited features.

U18. 6,041,315

U.S. Patent No. 6,041,315 to Pollin describes an automated payment system and method. The reference teaches a system and method for printing checks. *See e.g.*, Abstract and column 4, lines 66-67. The disclosure does not appear to teach beyond printing of the checks. *See e.g.*, Figure 2, wherein the method “ends” after a printing step further described in column 13, lines 38-49. This is dissimilar to independent claim 1, which recites the actual “deposit” of a check. Claim 1, line 12. Claims 15 and 21 recite similar limitations in lines 8 and 11, respectively. The reference therefore does not teach or suggest a system or

method as claimed in the subject application, including at least the actual "deposit" of a check and other recited features.

U19. 6,105,011

U.S. Patent No. 6,105,011 to Morrison, Jr., relates a security system and method for business transactions with customers. The invention disclosed in this reference involves the use of a personal identification card that may be applicable to a variety of applications. *See, e.g.*, column 2, lines 17-22 and 38-44. U.S. Patent No. 6,105,011 also teaches two specific applications of the card for *cashing* checks. One relates to a transaction with a teller, *see e.g.*, Figures 3A-C and description beginning in column 8, line 36; the other concerns withdrawal of cash from an ATM machine, *see e.g.*, Figures 5A & 5B, and the description beginning in column 11, line 18. By contrast, independent claim 1 of the present application recites the "deposit" of checks. Claim 1, line 12. claims 15 and 21 recite similar limitations in lines 8 and 11, respectively. The reference therefore does not teach or suggest a system or method as claimed in the subject application, including at least the actual "deposit" of a check and other recited features.

In summary, the art discovered by the Applicants during their pre-examination search activity relates to a variety of systems and methods directly or indirectly related to financial transactions. None of the references, however, either alone or in combination, suggest the system and method claimed in the present application.

On the basis of the foregoing, the Applicants respectfully request that the Commissioner grant this Petition to Make Special so that the application will be taken up promptly and examined accordingly.

Respectfully submitted,

By: Scott D. Balderston
Scott D. Balderston
Registration No. 35,436
HUNTON & WILLIAMS
1900 K Street, NW
Washington, DC 20006
(202) 955-1935

Dated: January 23, 2001

PATENT

Attorney Docket No. 47004.000059

Path: DOCSOPEN\WASHINGTON\03105\47004\000059\3vy\$06!.DOC

Doc #: 181386; V. 6

Doc Name: petition to make special

Author: Olsen, Steven R., 03105

Typist: Olsen, Steven R., 03105

Last Edit: 1/23/01 11:47 AM